

REMARKS

Reconsideration of the pending application is respectfully requested in view of the following observations.

1. In the Claims

Claim 1 is amended to replace the term “object” with the term “value document” and further replace the term “security cover sticker” with the term “scratch label.” Support for the amendatory language finds clear support in original claims 24 and 25 which are cancelled herein.

Claim 5 is amended by reciting that the at least one ink layer and at least one further ink layer or lacquer layer is disposed between the value document and the ink layer. This language is intended to clarify the scope of this claim by introducing a “further” ink layer or lacquer layer, and does not add new matter to the claim.

Likewise, claim 30 is amended by reciting that a “further” ink layer is applied to the lacquer layer. Support for this amendment is found in at least Fig. 3 by the additional ink layer (34).

Entry of the amendment to the claims is kindly requested in the next Office communication.

2. Claim Objections

In view of the amendment to claims 5 and 30 by indicating a “further” lacquer layer and ink layer, it is submitted that these claims clearly distinguish between the ink layer or lacquer layer in claim 1.

Removal of the objection to the claims is respectfully requested.

3. Rejection of claims 1, 5, 6, 9, 18, 30 and 32 under 35 U.S.C. § 112, first paragraph

In this rejection, the examiner contends that the written description does not sufficiently describe the recited “lacquer,” “UV lacquer” or “non-stick lacquer.” The applicant contends however, as evidenced by the comments by the examiner in the rejection, that the skilled person would readily recognize that a lacquer in a most general

sense is any resinous material that is typically applied to the surface of an object as either a protective coating or an adhesive. Such general understanding applies to the pending claims.

In view of the general understanding of a "lacquer," "UV lacquer" or "non-stick lacquer," it is submitted that no further description of these features is required in the written description. Accordingly, a skilled person would be able to sufficiently understand what is meant by these terms in the claims in order to practice the invention of the pending application.

In view of these observations, withdrawal of this rejection is kindly requested.

4. Rejection of claims 1, 2, 4, 5, 7-9, 12, 21, 23-29, 35 and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent application publication 2002/0020739 (*Annacone*)

Reconsideration of this rejection is respectfully requested in view of the amendment to claims and the following observations.

In observing Figs. 12B and 12H of *Annacone*, it is readily apparent that this prior art document does not disclose or suggest an additional layer, comprising an ink layer or a lacquer layer, that is disposed directly on a value document, as required by the pending claims.

While *Annacone* describes film layer 37b which comprises layers (37e) and (37f), the film layer (37b) is clearly not described as being "directly on a value document." Instead, the film layer (37b) is directly located on a base label layer (37a). According to *Annacone*, it is the base label layer (37a) which is secured to the card (23) via an adhesive (37d) ([0045]).

The base label (37a) is an essential part of the scratch-off label of *Annacone*, and cannot easily be omitted. *Annacone* explains that the base label (37a) is necessary for the transfer of a scratch-off label strip from a carrier web during is necessary for the transfer of the scratch-off label strip during an automated labeling process and applied onto a card ([0004]).

In contrast to the pending claims, the base label layer (37a) of *Annacone* is contrary to the assembly of the pending claims wherein the additional layer is directly applied to the value document, such that removal of the security cover sticker results in a clearly visible seal break, as explained in the written description at the 4th and 5th paragraphs on page 2 of the pending application. Instead, the base label layer (37a) of *Annacone* is arranged for enabling the transfer of a scratch-off label and therefore facilitates the lift-off of the scratch-off label, rather than resulting in a clearly visible seal break.

In view of these observations, it is submitted that *Annacone* fails to disclose every feature required by the pending claims. Accordingly, withdrawal of this rejection is respectfully requested.

5. Rejection of claims 1, 4-8, 23 and 25-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by DE 10109964 (*Fleischauer*)

Reconsideration of this rejection is respectfully requested in view of the amendment to the claims and the following observations.

In observing the drawing figure of *Fleischauer*, as best understood, it is readily apparent that this prior art document does not disclose or suggest an additional layer, comprising an ink layer or a lacquer layer, that is disposed directly on a value document, as required by the pending claims.

While *Fleischauer* describes a scratch-off label in the figure, the ink layer (8a, b) is disposed on layer (7) which in turn is a retro-reflective coating. However, the layer (7) is located on the base layer (1). The scratch label of the figure may be applied to a license plate of a vehicle. From these observations, it is clear that there is no understanding of directly disposing an additional layer on a value document, as particularly required by the pending claims.

As amended, claim 1 requires a scratch label instead of a security cover sticker, which can be identified with layer (2) of *Fleischauer*. The transparent layer (4) is disclosed by *Fleischauer* is understood as having a protective function. From this examination, *Fleischauer* fails to disclose any adhesive strength between the additional

layer, as equated in the rejection as layers (8a, b) of *Fleischauer*, and the scratch label (2), because the layers (2) and (8a, b) are not in direct contact with one another, but are instead separated by layer (4).

Since it is understood that the transparent layer (4) is important in the label of *Fleischauer* for protecting the information (3), *Fleischauer* clearly does not disclose omitting the layer (4). Because the omission of layer (4) would be necessary to produce an assembly according to amended claim 1, *Fleischauer* cannot be construed to teach every feature required by the pending claims.

In view of these observations, it is submitted that *Fleischauer* fails to anticipate the pending claims. Accordingly, withdrawal of this rejection is respectfully requested.

6. Rejection of claims 3, 6, 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2002/0020739 (*Annacone*)

In view of the discussion above on the shortcomings of *Annacone*, it is submitted that the skilled person would not understand from *Annacone* to modify the basic construction of the debit card of *Annacone* in a manner required by the pending claims.

Accordingly, *Annacone* does not render the pending claims obvious, and the pending claims are therefore patentable over *Annacone*.

Withdrawal of this rejection is therefore courteously requested.

7. Rejection of claims 13-30 and 30-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2002/0020739 (*Annacone*) and DE 10109964 (*Fleischauer*) in view of U.S. patent 3,631,617 (*Pekko*)

As established above, the disclosures of *Annacone* and *Fleischauer* neither anticipate nor render unpatentable the pending claims. *Pekko* fails to make up for the shortcomings of *Annacone* and *Fleischauer*. Further, the rejection does not rely on *Pekko* to teach the omitted features of *Annacone* and *Fleischauer*.

Reconsideration of this rejection is respectfully requested in view of the explanation on the shortcomings of *Annacone* and *Fleischauer* provided above in

reference to claim 1, from which some of the claims of this rejection depend. Also, the observations on claim 1 in view of *Annacone* and *Fleischauer* can be equally applied in reference to the method of claim 28 from which other claims of this rejection depend.

In view of these observations, the proposed combination of *Annacone*, *Fleischauer* and *Pekko* fails to render the rejected claims unpatentable. Accordingly, withdrawal of this rejection is respectfully requested.

8. Rejection of claims 22 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2002/0020739 (*Annacone*) in view of U.S. patent application publication 2002/0038321 (*Feilen*)

Reconsideration of this rejection is requested in view of the discussion on the shortcomings of *Annacone* provided above in reference to independent claims 1 and 28, from which claims 22 and 33 depend, respectively.

The disclosure of *Feilen* fails to make up for the shortcomings of *Annacone*

In view of these observations, the proposed combination of *Annacone* and *Feilen* fails to render the rejected claims unpatentable. Accordingly, withdrawal of this rejection is respectfully requested.

9. Rejection of claim 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 10109964 (*Fleischauer*)

In view of the discussion above on the shortcomings of *Fleischauer*, it is submitted that the skilled person would not understand from *Fleischauer* to modify the basic construction of the debit card of *Fleischauer* in a manner required by the pending claims.

Accordingly, *Fleischauer* does not render the pending claims obvious, and the pending claims are therefore patentable over *Fleischauer*.

Withdrawal of this rejection is therefore courteously requested.

10. Rejection of claims 2, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 10109964 (*Fleischauer*) in view of U.S. patent application publication 2002/0020739 (*Annacone*)

In view of the discussion above on the shortcomings of *Fleischauer* and *Annacone*, it is submitted that the skilled person would not understand from *Fleischauer* and *Annacone* to modify the basic construction of the scratch label in *Fleischauer* with the teachings of *Annacone* in a manner required by the pending claims.

Accordingly, the combination of *Fleischauer* and *Annacone* does not render the pending claims obvious, and the pending claims are therefore patentable over *Fleischauer* and *Annacone*.

Withdrawal of this rejection is therefore courteously requested.

11. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicant's attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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